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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|------------------------------|------------------|
| 10/692,016 | 10/24/2003 | John Joseph O'Connor | 604-697 | 8514 |
| 23117 | 7590 | 06/01/2005 | | |
| NIXON & VANDERHYE, PC 901 NORTH GLEBE ROAD, 11TH FLOOR ARLINGTON, VA 22203 | | | EXAMINER STEWART, ALVIN J | |
| | | | ART UNIT 3738 | PAPER NUMBER |

DATE MAILED: 06/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|---|-------------------------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/692,016 Examiner Alvin J Stewart | O'CONNOR ET AL. Art Unit 3738 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 25 April 2005.
 2a) This action is **FINAL**. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-24 is/are pending in the application.
 4a) Of the above claim(s) 9,10,12,13 and 15-24 is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-3 and 5-8 is/are rejected.
 7) Claim(s) 4,11 and 14 is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on 24 October 2003 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. 10014920.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
 Paper No(s)/Mail Date 10/24/03.
- 4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date. _____ .
 5) Notice of Informal Patent Application (PTO-152)
 6) Other: _____ .

Election/Restrictions

Applicant's election without traverse of Group I, species III in the reply filed on 04/25/05 is acknowledged.

Claims 9, 10, 12-13 and 15-24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group and/or species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 25, 2005.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5, 6 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Albrektsson US Patent 4,728,332.

Albrektsson discloses a knee prosthesis comprising a tibial component (4 & 5) having a first, upper surface and a second lower surface. The first surface including a lateral bearing region and a medial bearing region, wherein the respective angles of inclination of the lateral and medial bearing regions of the first surface with respect to the second surface are dissimilar (see Figs. 2-5a; col. 4, lines 52-58).

Claims 1-3, and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by Cooke et al US Patent 6,190,415 B1.

Cooke et al discloses a knee prosthesis comprising a tibial component (2) having a first, upper surface and a second lower surface. The first surface including a lateral bearing region (14) and a medial bearing region (12), wherein the respective angles of inclination of the lateral and medial bearing regions of the first surface with respect to the second surface are dissimilar (see Fig. 1).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Albrektsson US Patent 4,728,332.

Albrektsson discloses the invention substantially as claimed. However, Albrektsson does not disclose a lateral bearing region is substantially parallel to the second surface and said medial bearing region is inclined at a negative angle to the second surface.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the angle of the lateral and medial bearing region of the tibial component of the Albrektsson reference because Applicant has not

disclosed that the change of angle in each bearing region provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the Albrektsson angle because both angles would perform equally well.

Therefore, it would have been an obvious matter of design choice to modify Albrektsson reference to obtain the invention as specified in claim 8.

Allowable Subject Matter

Claims 4, 11 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin J Stewart whose telephone number is 571-272-4760. The examiner can normally be reached on Monday-Friday 7:00AM-5:30PM(1 Friday B-week off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3738

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A. Stewart
ALVIN J. STEWART
PRIMARY EXAMINER
Art Unit 3738

May 23, 2005.